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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vetements Weill

Serial No. 78321221

Julie B. Seyler of Abelman, Frayne & Schwab for applicant.

Rebecca L. Gilbert, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Vetements Weill to
register the mark shown below



("PARIS" disclaimed) for "clothing, namely, tops, shirts,
pants, sweaters, jackets, coats, ties, dresses, suits,

shorts, lingerie, sleepwear, swimwear; footwear; headwear; leather pelisses and gloves."¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the previously registered marks shown below.



for "perfumes, bath salts, toilet water;"²

RAYMOND WEIL (standard character form) for "mechanical watches with manual and automatic winding, electric and electronic watches, watch movements, cases, dials and bracelets; watch parts, divers' watches, chronometers; chronographs; electric, electronic or manually wound table clocks and alarm clocks; costume jewelry; jewelry made wholly or partially of precious metals and jewelry watches;"³



¹Application Serial No. 78321221, filed October 30, 2003, alleging first use anywhere and first use in commerce on January 31, 1989.

²Registration No. 617604, issued December 12, 1955; renewed twice. The registration indicates that Section 2(f) has been claimed as to the entire mark, and that the words "Parfums" and "Paris" are disclaimed.

³Registration No. 1090831, issued May 9, 1978; renewed. The registration indicates that "'Raymond Weil' is a living individual, who is president of [registrant], whose consent is of record."

for "watches;"⁴ and

TANGO BY RAYMOND WEIL (standard character form)
for "watches."⁵

The last three cited registrations are owned by the same entity.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney maintains that the dominant feature of each of the cited marks is WEIL, and that this feature is the phonetic equivalent of the dominant portion, WEILL, of applicant's mark. The goods are also related, the examining attorney contends, because clothing designers sell, among other things, clothing, perfumes, watches and jewelry under their designer names. In support of the refusals, the examining attorney submitted third-party registrations showing, according to the examining attorney, that clothing designers have registered their names for clothing, as well as for watches, jewelry and perfume. The examining attorney also submitted third-party registrations to show that various designers have registered their full

⁴Registration No. 1474908, issued February 2, 1988; Sections 8 and 15 affidavit accepted and acknowledged.

⁵Registration No. 2437761, issued March 27, 2001. The registration indicates that "'Raymond Weil' identifies a living individual whose consent is of record."

names (given name plus surname) as well as just their surnames.

Applicant asserts that the examining attorney has impermissibly dissected the marks. Further, applicant argues that each of the cited marks has a different commercial impression from the one engendered by its mark, and that the presence of the surname WEIL in the cited marks renders them weak and, thus, the registrations are entitled to a narrow scope of protection. Applicant also contends that the goods are not commercially related: "[t]he fact that clothing designers license their name for use on eyewear, jewelry, perfume and even furniture is not evidence to show a commercial relationship between such goods where the marks are visually, verbally and connotatively dissimilar, and none of the cited registrations are used in connection with clothing." (Appeal Brief, p. 9). Applicant also points to the coexistence of the cited marks on the register and states that, despite applicant's use of its mark since 1989, applicant is not aware of any instances of actual confusion with any of the registered marks.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set

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forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Registration No. 617604 (PARFUMS WEIL PARIS--stylized)

We first turn to a comparison of the marks. Of the four cited registrations, this one is the most similar to applicant's mark. Although we have compared the marks in their entireties, there is nothing improper in giving more weight to a particular feature of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We agree with the examining attorney that the dominant portion of applicant's mark is the term WEILL. It is well established that, in the case of a logo mark, the literal portion of a mark generally is the dominant feature because it is the element by which consumers will refer to and call for the goods. *In re Dacombe*, 9 USPQ2d 1813, 1814 (TTAB 1988). Further, descriptive matter generally is

subordinate to source-identifying portions of a mark. Thus, the WEILL portion of applicant's mark dominates over the geographically descriptive and disclaimed term PARIS and the horse and carriage design in applicant's mark. It also is clear that the term WEIL in registrant's mark is the dominant feature of the registered mark; the generic term PARFUMS and the geographically descriptive term PARIS (both of which are disclaimed) are subordinate to WEIL.

Because of the presence of the similar dominant portions, WEIL and WEILL (as well as the same geographic term PARIS), the marks are similar in sight and sound. Consumers are not likely to note or remember that WEIL and WEILL differ by the presence or absence of the letter "L", nor will they distinguish the marks based on this slight difference. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). As to meaning, to the extent that purchasers ascribe a surname significance to WEIL and WEILL, the marks will have the same connotation. As a result, both marks convey similar commercial impressions. Thus, the marks are sufficiently

similar that, if related goods were sold thereunder, consumers likely would be confused.

We next turn to the du Pont factor regarding the similarity or dissimilarity of the parties' respective goods. In comparing the goods, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). The issue of likelihood of confusion must be determined on the basis of the goods as set forth in the application and the cited registration. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

The merits of this refusal turn on the similarity/dissimilarity between the goods of applicant and this registrant. The underlying basis of the examining

attorney's conclusion regarding the second du Pont factor is that the involved marks are "designer marks." The examining attorney asserts that "[d]esigners sell all of these goods under their designer name, therefore, when used in connection with a designer's name, consumers would be likely to confuse the source of the goods." The examining attorney goes on to state "[a]pplicant is a clothing designer and clothing designers tend to place their marks on watches, jewelry and perfume," and, "[w]hen used in connection with such similar designer marks, these goods are sufficiently similar to cause confusion in the marketplace." (Appeal Brief, pp. 6-7).

The problem with the examining attorney's analysis, as we see it, is that there is no evidence indicating that either applicant or registrant is a designer, or that consumers would perceive the terms as referring to designers. Thus, we do not view this case as falling within the purview of the designer mark cases wherein more varied goods were found to be related because of the practice of designers to license their names for a wide variety of goods.⁶ Cf. *Nina Ricci, S.A.R.L. v. ETF*

⁶We note that the cases cited by the examining attorney involving fashion designer names are inter partes cases. In this connection, we appreciate the fact that evidence of whether an entity is a designer is often not available to examining attorneys and, thus, this is an issue normally resolved in an inter partes proceeding.

Enterprises, Inc., 203 USPQ 947 (TTAB 1979); and David Crystal, Inc. v. Dawson, 156 USPQ 573 (TTAB 1967).

Outside of the designer mark context, there is no inherent relatedness between clothing, on the one hand, and perfumes, bath salts and toilet water, on the other. In attempting to draw a connection between the two different types of products, the examining attorney relied upon third-party registrations. Third-party registrations which individually cover a number of different items, and which are based on use in commerce, serve to suggest that the listed goods are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). A close review of these registrations, however, does not support the conclusion urged by the examining attorney.

The third-party registrations owned by a single entity for both clothing items and perfumes and other toiletry products are the following: Reg. No. 1031093 (FERRAGAMO for clothing) and Reg. No. 2537519 (FERRAGAMO for perfumes); Reg. No. 1016032 (SALVATORE FERRAGAMO for clothing) and Reg. No. 2296242 (SALVATORE FERRAGAMO for perfumes); Reg. No. 1730539 (GIANFRANCO FERRE for clothing and perfumes); Reg. No. 1373892 (BOSS CREATION HUGO BOSS PARIS for clothing) and Reg. 2399198 (BOSS HUGO BOSS for

perfumes); Reg. No. 1795115 (LIZ CLAIBORNE for clothing) and Reg. No. 2826541 (SPARK LIZ CLAIBORNE for perfumes); and Reg. No. 2878673 (H HILFIGER for clothing) and Reg. No. 2634237 (TOMMY HILFIGER for toiletry items).⁷

The problem with these registrations is that they show only three marks that have been registered by entities (one entity owns two of the marks) for the types of goods involved herein. Although there are also three entities which have registered variations of marks (e.g., H HILFIGER and TOMMY HILFIGER) for different goods, the Trostel case refers only to third-party registrations of a single mark as being evidence of the relatedness of the goods identified in the registrations. Even if we were to consider the registrations of all five entities, however, the evidence falls short in showing that applicant's goods and the goods in the cited registration are related. All of these registrations appear to involve designer marks and, as indicated earlier, we have no evidence that applicant's or registrant's mark herein is a designer mark. Based on this record, therefore, we cannot find that perfumes and clothing items are related goods, such that

⁷Some of the entities own additional registrations of similar marks that cover slightly different identifications of goods. For example, Tommy Hilfiger Licensing, Inc. also owns Reg. No. 2390195 (HILFIGER ATHLETICS for cologne).

consumers would assume that they emanate from a single source if they were sold under similar marks.

In view of the above, this refusal is reversed.

Registration Nos. 1090831; 1474908; and 2437761 (RAYMOND WEIL marks)

With respect to the second duPont factor regarding the similarity between the goods, the Examining Attorney has not shown that there is a relatedness between clothing, on the one hand, and watches and jewelry, on the other. With regard to these three cited registrations, as was the case with the cited registration for PARFUMS WEIL PARIS, the examining attorney has relied upon third-party registrations of designer name marks to suggest a connection between clothing and watches and jewelry. These registrations show that the same five entities discussed above (Salvatore Ferragamo Italia, S.P.A. corporation Italy via die Tornabuoni; Hugo Boss A.G.; Gianfranco Ferre S.P.A.; L.C. Licensing, Inc.; and Tommy Hilfiger Licensing, Inc.) have registered the same or a similar designer name mark for both clothing and watches and jewelry. However, inasmuch as there is nothing in the record to show that either WEILL (the term in applicant's mark) or RAYMOND WEIL (the name in the cited marks) is a designer name, we do not find the third-party registrations to be persuasive on this

factor. While the third-party registrations suggest that designer names may be used as marks for a variety of products, the record does not include evidence that any entity, other than a fashion designer, sells clothing and watches and jewelry under the same mark. Thus, there simply is no probative evidence to establish that consumers are likely to believe that applicant's clothing and registrant's watches and jewelry emanate from the same source.

In view thereof, despite some similarities in the marks, we find that the Office has failed to prove that confusion is likely to occur from applicant's use of its mark on its identified clothing items.

Decision: The refusals to register are reversed.